

CFR §1.141 deals explicitly with "independent and distinct inventions"<sup>4</sup> even permitting five of them to be patented on one application along with a generic claim. As to species in excess of five specifically claimed, it is implicit that they may still fall within the "coverage" of the generic claim even if separately patented. It is elementary patent law that the number of "species" "covered" by a patent having a generic claim is virtually without limit notwithstanding the limitation of Rule 141 to five species "specifically claimed." So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim — no matter how broad, which means no matter how many independently patentable inventions may fall within it.

Of course a broad claim may be unpatentable for any number of reasons, but we are not here dealing with a question of patentability under the statute but with a refusal to examine.

The only basis here claimed in support of the labels "improper" and "misjoinder" is the scope of the claim. That is not sufficient excuse.

As for the true meaning of the words "two or more independent and distinct inventions are claimed" in §121, being based — as they were — on the "division" practice existing in the then Patent Office in 1952, there can be no doubt they refer to separate inventions separately claimed and to a requirement to put separate claims in separate applications or at least to restrict one application to one claimed invention. There is no indication that enactment of §121 contemplated refusing examination to generic claims because of their scope or that applicants were to be denied the right to present single claims of any breadth they chose and have them examined.

The PTO effort of the past few years to justify its refusal to examine by issuing a "rejection" pursuant to the May 1, 1974, notice (MPEP 803) on the basis of §121 is mere semantic gamesmanship.

With respect to the remand to consider the "improper Markush" rejection of claims 1-6, it is my view, based on careful analysis of the rejections actually made,

that the PTO, following the May 1, 1974, notice (922 OG 1016), created a new kind of "improper Markush" rejection based on 35 USC 121 which we are reversing. There remains, however, a vast body of precedent antedating the 1974 notice on what proper "Markush" claims are. As I understand the majority's remand, it is for the purpose of examining claims 1-6 under the pre-notice law relating to Markush practice in the process of examining these claims on their merits. Until now, such examination has been refused because they "cover" or "embrace" too much, a basis of rejection we find impermissible.

### Court of Customs and Patent Appeals

In re Haas

No. 78-536

Decided June 30, 1978

### PATENTS

#### 1. Court of Customs and Patent Appeals — Issues determined — Ex parte patent cases (§28.203)

There is no issue before Court of Customs and Patent Appeals that claims are drawn to improper Markush groups where there is no rejection on that ground.

#### 2. Applications for patent — Divisional (§15.5)

##### Claims — Miscellaneous objections (§20.70)

##### Joinder of invention — In general (§42.01)

##### Pleading and practice in Patent Office — Rejections (§54.7)

Section 121 does not provide basis for rejection of claim.

##### Particular patents — Polymerization

Haas, Novel Polymerization Initiators, rejection of claim 7 and 8, reversed and remanded.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Howard C. Haas, Serial No. 821,511, filed May 2, 1969 continuation-in-part of application, Serial No. 630,222 filed Apr. 12, 1967. From decision rejecting claims 7 and 8, applicant appeals. Reversed and remanded.

<sup>4</sup> Note Rule 141's wording: "Two or more independent and distinct inventions may not be claimed in one application, *except* \* \* \*." (My emphasis.) Compare the wording of 35 USC 121.

EXHIBIT

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See also 175 USPQ 217; 179 USPQ 623; and 188 USPQ 374.

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Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

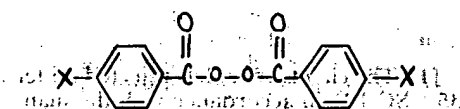
Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Markey, Chief Judge.

This appeal is from a decision of the United States Patent and Trademark Office (PTO) Board of Appeals (board) affirming a final rejection under 35 USC 121 of claims 7 and 8 of application serial No. 821,511, filed May 2, 1969, entitled "Novel Polymerization Initiators."<sup>1</sup> We reverse and remand.

#### Invention

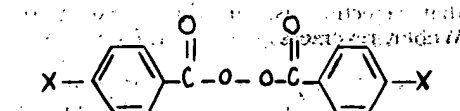
The invention is a group of benzoyl peroxides:



useful as initiators for polymerization of vinyl-containing compounds or monomers. Haas states: "The substituent X does not participate in the polymerization initiation, but it does introduce into the resulting polymer a reactive, terminal group at one or both ends of the resulting polymer chain. Thus, while the resulting polymers may have different utilities, all of the claimed compounds have the same utility [i.e., polymerization initiators]."

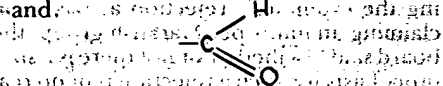
Claims 7 and 8 are the sole claims on appeal.

7. A compound of the formula

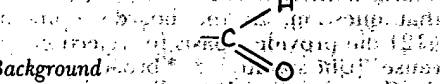


A<sup>2</sup> continuation-in-part of serial No. 630,222, filed April 12, 1967.

wherein X is selected from the group consisting of  $\alpha$ -monosubstituted chloro, bromo and fluoro alkyl groups containing from 1-3 carbon atoms, inclusive; and



8. The invention of claim 7, wherein X is selected from the group consisting of  $\alpha$ -monosubstituted chloro alkyl groups containing from 1-3 carbon atoms, inclusive; and



#### Background

Haas comes before this court for the second time on the present application. In *In re Haas*, 486 F.2d 1053, 179 USPQ 623 (CCPA 1973) (Haas I), the examiner held claims 1 and 2 withdrawn from further consideration under 35 USC 121 as drawn to multiple patentable (sic, patentably) distinct inventions.<sup>2</sup> This court held that "withdrawal" of a claim from consideration, under those circumstances, constituted a rejection reviewable by the board under 35 USC 7 and 134, and by this court under 35 USC 141. The decision of the board to dismiss for lack of jurisdiction was reversed, and the case was remanded for further action consistent with the opinion.

The board remanded the case to the examiner. The examiner rejected claims 1 and 2 "as improper Markush claims and for misjoinder [of invention] under 35 USC 121, because drawn to multiple independent and distinct inventions. Though initially arguing that claims 1 and 2 did not define independent and distinct inventions, Haas expressly abandoned that argument on appeal to the board and conceded "that his recited Markush group contains multiple independent and distinct inventions in the same sense that a generic term may contain multiple independent and distinct inventions." In view of that concession, the board stated: "[T]he only question presented by this appeal is whether or not a single claim which includes a plurality of independent and distinct inventions is legally rejectable."<sup>3</sup> The board answered affirmatively.

<sup>2</sup> Claim 2 was dependent from claim 1 and limited substituent X to the para position of the benzene rings. The "independent and distinct" inventions were thus alleged to fall within claim 1 alone or claims 1 and 2 taken together.

<sup>3</sup> Ex parte Haas, 188 USPQ 374, 376 (PTO

In its opinion, the board viewed the examiner's rejection as based on claiming an improper Markush group and misjoinder of invention under 35 USC 121. In affirming the examiner's rejection as based on claiming an improper Markush group, the board said "[w]hether or not there is a statutory basis for such a rejection is of no real concern, since such a rejection has basis at least in established judicial doctrine,"<sup>4</sup> and that it was unnecessary to decide whether §121 provided a basis for rejection. The board, nonetheless, proceeded to decide that question. In the board's opinion, §121 did provide a basis for rejection because "[t]he statute \* \* \* broadly permits the Commissioner, in his discretion, to refuse to grant a patent on an application containing two or more independent and distinct inventions."<sup>5</sup> Additionally, the board entered rejections under 37 CFR 1.196(b) based upon §102(b), §112, first paragraph, and §112, second paragraph. One board member, dissenting-in-part, stated that he did not agree that "independent and distinct inventions" were claimed, despite Haas' admission.

Haas elected to carry on further prosecution before the examiner. 37 CFR 1.196(b). Following an amendment adding two claims numbered 6 and 7, the examiner finally rejected claims 1, 2, 6 and 7, inter alia, "as improper Markush claims and misjoinder under 35 USC 121." Other rejections included *res judicata* (claims 1 and 2), 35 USC 132 (claims 6 and 7, new matter), and 35 USC 102(b) (claims 1, 2, 6 and 7). A claim 5, apparently originally allowed, was rejected under 35 USC 112, first paragraph, because the board's §1.196(b) rejection under §112, first paragraph, of claims 1 and 2 applied to claim 5 as well. Haas proposed present claim 8 in an after-final amendment. 37 CFR 1.116, entered by the examiner with the understanding that claim 8 stood rejected for the same reasons applied to claims 5, 6 and 7.

On appeal, under a heading "35 USC 121 Rejection," the board stated: "This rejection, as acknowledged by the appellant, raises the same issues as were involved in the Examiner's rejection under 35 USC 121 involved in the previous appeal." Noting that Haas had not raised any additional arguments and relied upon arguments made in the previous appeal, the

board affirmed the rejection "for the reasons given by us [in the previous appeal]." The board proceeded to reverse the §132 rejection, the *res judicata* rejection, and the §102(b) rejection as to claims 7 and 8, but affirmed the §102(b) rejection as to claims 1, 2, 5 and 6, and affirmed the §112, first paragraph rejection of claims 1, 2, 5 and 6. The board further entered a 37 CFR 1.196(b) rejection of claims 1, 2, 5, 6, 7, and 8 under 35 USC 112, second paragraph. The dissenting board member in the previous appeal filed a concurrence again expressing his opinion that the claims, particularly claims 7 and 8, did not recite independent and distinct inventions, but agreed to the result in view of Haas' concession.

Prosecution again returned to the examiner. Haas cancelled claims 1, 2, 5 and 6, rewrote claim 7 in independent form, and otherwise amended the claims mooting all issues save the issue under §121. Thus, on the third and final appearance before the board, only claims 7 and 8 remained and stood rejected "under 35 USC 121 as containing improper Markush groups and misjoinder of inventions in the combination of the members in said Markush groups." In that appearance, the board made final its previous decision affirming that rejection.

#### Issue

[1] The claims are solely rejected under 35 USC 121 in accordance with the mandate in the Manual of Patent Examining Procedure (MPEP) 803 as containing "improper Markush groups and [for] misjoinder of inventions" because those claims are viewed as directed to independent and distinct inventions.<sup>6</sup> Accordingly, the issue is whether §121 furnishes a basis for rejecting a claim.

#### Opinion

[2] In *In re Weber*, 198 USPQ 328, decided of even date, this court holds that §121 does not provide a basis for rejection of a claim. To the extent that §121 was employed in this case as a basis for rejection, that rejection is, on the authority of *Weber*, reversed.

Bd. App. 1975).

<sup>4</sup> Id.

<sup>5</sup> Id. at 377.

<sup>6</sup> There is no rejection and, consequently, no issue before us that the claims are drawn to improper Markush groups as described by the PTO in MPEP 706.03(y).

The examiner's rejection of claims 7 and 8 herein as "improper Markush" claims is inextricably intertwined on this record with the application of §121. The solicitor's brief states that the examiner is willing to examine claims 7 and 8 as a whole on their merits.

Accordingly, the decision of the board is reversed and the case is remanded for examination of claims 7 and 8 on their merits.

*Reversed and Remanded*

### Court of Customs and Patent Appeals

In re The Clorox Company

No. 77-628 Decided June 30, 1978

### TRADEMARKS

#### 1. Registration — In general (§67.731)

##### Registration — Supplemental Register (§67.765)

Examiner of Trademarks and Patent and Trademark Office Trademark Trial and Appeal Board are charged, under Lanham Act Section 2(d), with duty of refusing registration of mark, whose use is likely to cause confusion because of its resemblance to mark registered in Patent and Trademark Office; Lanham Act Section 23 indicates that Supplemental Register is continuation of register provided in paragraph (b) of Section 1 of Act of March 19, 1920; Section 2(d)'s absence from enumeration of statutory provisions made inapplicable to Supplemental Register establishes unequivocally its applicability to registrations on Supplemental Register.

#### 2. Identity and similarity — In general (§67.401)

##### Identity and similarity — How determined — In general (§67.4051)

##### Registration — In general (§67.731)

Protection envisaged by Trademark Act Section 2(d) is not that of marks against mere registration of other marks, hence conflict must occur in marketplace; refusal to register conflicting mark does not protect registered mark against use of con-

flicting mark in marketplace; users of trademarks and owners of registrations, when they seek protection of their marks, are necessarily protecting their right to unconfused public; and are serving statutory goal of protecting public against confusion; sole duty of Trademark Examiner, Trademark Trial and Appeal Board, and Court of Customs and Patent Appeals, under Trademark Act Section 2(d), is to determine whether confusion is likely; confusion sought to be prevented by Trademark Act is not that of examiners, lawyers, board members, or judges; confusion is likely, if at all, only in marketplace where marks are used; registration is itself incapable of causing confusion; Patent and Trademark Office is not charged under Trademark Act Section 2(d) with duty of permitting or denying right to use any mark, or of protecting any registered mark against mere registration of similar marks, unless use of latter would be likely to cause confusion.

#### 3. Identity and similarity — How determined — In general (§67.4051)

##### Registration — Supplemental Register (§67.765)

##### Statutes and treaties (§67.80)

Mark registered on Supplemental Register can be used as basis for refusing registration to another mark under Trademark Act Section 2(d); resort to legislative history is unnecessary where Trademark Act language is clear and unambiguous.

#### 4. Cancellation — In general (§67.171)

##### Registration — Supplemental Register (§67.765)

Marks registered on Supplemental Register are required to be capable of distinguishing applicant's goods or services under Trademark Act Section 23; party has cancellation proceeding available under 15 U.S.C. 1092 if registrant was not entitled to registration, on grounds that mark is common descriptive term and thus incapable of indicating origin of goods, or because mark is not used by registrant or has been abandoned.